

REMARKS

Claims 1-15 are pending in the present application. Claim 16 is canceled. Claims 1, 10, and 15 are amended. Reconsideration of the claims is respectfully requested.

1. 35 U.S.C. § 101

The Office Action rejects claim 15 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

With respect to claim 15, the Office Action states:

Claim 15 is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

The Examiner respectfully requests Applicants to expressly state whether they intend to claim a product claim or a process claim. On one hand, it appears Applicants are claiming a medium (a product claim placing it within the §101 category of a machine since the preamble of claim 15 states "A computer program product ...") and yet are still attempting to claim a method or process claim ("the following method steps: ...").

Office Action, dated July 29, 2003. Applicant respectfully disagrees. Claim 15 is amended to recite a computer program product comprising instructions for performing the recited functions. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure that increases computer efficiency held statutory). Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture, machine, or process. The Office Action does not analyze the underlying process and, thus, does not establish that the claim is unstatutory.

To the contrary, Applicant submits that claim 15 recites a computer program product on a computer readable medium, wherein the computer program product includes instructions that perform functions that provide a practical application in the technological arts. For these reasons, claim 15 is statutory and the rejection under 35 U.S.C. § 101 is overcome.

II. 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 15 and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

As to claims 15 and 16, the Office Action states:

Claim 15 is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention. Its therefore unclear whether Applicant(s) are claiming a process or a machine. See MPFP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990) and the §101 rejection above.

Office Action, dated July 29, 2003. Applicant respectfully disagrees. Claim 15 is amended to recite a computer program product comprising instructions for performing the recited functions. As amended, claim 15 is directed to a single statutory class and is clear and unambiguous.

Therefore, the rejection of claims 15 and 16 under 35 U.S.C. § 112, second paragraph is overcome.

III. 35 U.S.C. § 102, Anticipation

The Office Action rejects claim 15 under 35 U.S.C. § 102 as being anticipated by 'StreetPrices.com' website printout of January 25, 1999 ("Streetprices 1/99"). This rejection is respectfully traversed.

With respect to claim 15, the Office Action states:

Streetprices 1/99 discloses generating a set of product profiles (see e.g. 'Computer', 'Flowers' and 'Toys'), each identifying a given site URL (inherent); a list of one or more included items to be queried (inherent), a scan interval (inherent in the graphs) and a site template (inherent in the search engine); periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the data records (inherent); and the product profiles include one or more triggers (a threshold price which sends an email when a price drops below a particular level).

Claims 15 and 16 are alternatively rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. In this case, evidence to support the public use is the StreetPrices.com website. See the additional

cited StreetPrices.com printout noted below and the Streetprices 1/99 noted above.

Office Action, dated July 29, 2003. Applicant respectfully disagrees. Streetprices appears to be a search engine, at a Web server, for identifying products and prices from multiple vendors. Streetprices apparently uses "robots" to crawl e-commerce web sites, uses categorization algorithms to improve results, and offers e-mail price alerts to customers when a price drops below a threshold.

In contradistinction, the present invention provides a computer program product at a client computer for collecting product data. Claim 15 recites:

15. A computer program product having a set of instructions executable by a processor for use in a client computer for collecting product data, the computer program product comprising:
instructions for generating a set of product profiles each identifying a given site URL, a list of one or more included items to be queried, a scan interval, and a site template;
instructions for periodically retrieving data for a given product profile from the given site URL according to the scan interval; and
instructions for parsing the data retrieved from the given site URL according to the site template to generate a data record for each included item comprising at least an item name and an associated price value.

None of the Streetprices references teaches or suggests a computer program product "having a set of instructions executable by a processor for use in a client computer for collecting product data," as recited in claim 15. Streetprices is clearly a Web site, which is embodied and executed on a Web server.

Furthermore, none of the Streetprices references teaches or suggests "parsing the data retrieved from the given site URL according to the site template to generate a data record for each included item comprising at least an item name and an associated price value," as recited in claim 15. There is no suggestion, explicit or implicit, that the Streetprices Web site uses a site template to parse data retrieved from a given site URL.

The Office Action misapplies the concept of "inherent" anticipation. Section 102 of Title 35 deals with novelty and loss of patent rights. An invention is said to be "anticipated" when it is squarely described or disclosed in a single reference as identified from one of the categories of 35 U.S.C. § 102, commonly referred to as "prior art." Express anticipation occurs when the invention is expressly disclosed in the prior art,

patent or publication. In some cases, however, when the claimed invention is not described *in haec verba*, the "doctrine of inherency" is relied on to establish anticipation. Under the principles of inherency, a claim is anticipated if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986).

A prior art reference that discloses all of a patent's claim limitations anticipates that claim even though the reference does not expressly disclose the "inventive concept" or desirable property the patentee discovered. *Verdygall Brothers, Inc. v. Union Oil Company of California*, 814 F.2d 628, 2 U.S.P.Q.2d 1051, (Fed. Cir. 1987). It suffices that the prior art process inherently possessed at that property. *Id.* Mere possibilities or even probabilities, however, are not enough to establish inherency. The missing claimed characteristics must be a "natural result" flowing from what is disclosed. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference are inherent when they exist as a "matter of scientific fact." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Cl. Cl. 1988). Otherwise, the invention is not inherently anticipated.

In the present case, the examiner's assertion that these elements are present can be made only through the use of the applicant's disclosure as a template to fill in the missing elements. The Office Action does not establish any necessity, natural result, or scientific fact to support a conclusion of inherency. The Office Action merely cites a Web site that is somewhat similar to the client-based invention and simply dismisses all of the claim limitations as inherent.

Since the applied references fail to teach each and every claim limitation, claim 15 is not anticipated by Streetprices. Therefore, the Office Action fails to establish a *prima facie* case of anticipation and the rejection should be withdrawn. Therefore, the rejection of claim 15 under 35 U.S.C. § 102 is overcome.

Furthermore, Streetprices does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Streetprices actually teaches away from the presently claimed invention because it teaches a Web site embodied and executed on a Web server, as opposed to a computer program product

having a set of instructions executable by a processor for use in a client computer, as in the presently claimed invention. Absent the Office Action pointing out some teaching or incentive to implement Streetprices on a client computer, one of ordinary skill in the art would not be led to modify Streetprices to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Streetprices in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

IV. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 1-15 under 35 U.S.C. § 103 as being unpatentable over Streetprices 1/99. This rejection is respectfully traversed.

With respect to claim 15, the Office Action states:

It is the Examiner's principle position that claims 15 and 16 are anticipated because of the inherencies noted above. However, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Streetprices 1/99 to include a URL, a list of excluded items, a scan interval and scan date. While including the URL would have made the searching more efficient, including a scan interval would have tailored the program to include items with different price volatilities. For example, real estate prices generally do not change hourly while airline tickets and consumer products may.

Office Action, dated July 29, 2003. Applicant respectfully disagrees. The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In comparing Streetprices to the claimed invention, the recited limitations of the present claims may not be ignored in an obviousness determination. In this case, the Office Action merely cites a Web site that is somewhat similar to the client-based invention and simply dismisses the claim limitations as obvious.

Claim 15 recites, "instructions for parsing the data retrieved from the given site URL according to the site template to generate a data record for each included item comprising at least an item name and an associated price value." In the obviousness

rejection, the Office Action simply fails to address this limitation. Applicant submits that none of the Streetprices references teaches or suggests "parsing the data retrieved from the given site URL according to the site template to generate a data record for each included item comprising at least an item name and an associated price value," as recited in claim 15. There is no suggestion, explicit or implicit, that the Streetprices Web site uses a site template to parse data retrieved from a given site URL.

Since the applied references fail to teach or fairly suggest each and every claim limitation, claim 15 cannot be rendered obvious by the Streetprices references. Therefore, the rejection of claim 15 under 35 U.S.C. § 103 is overcome.

With respect to claims 1-14, the Office Action states:

These claims represent different groups of inventions. Applicants have admitted in their latest response (Paper No. 8, Page 5) that the patentability of these groups (and claims) is dependent upon the rejection of claims 1-14. The Examiner relies on this admission. Functional recitations using the word "for" (e.g. "for collecting product data" as recited in claim 15) have been given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Office Action, dated July 29, 2003. Applicant respectfully disagrees. Even assuming, *arguendo*, that claim 15 is not patentably distinct from claims 1-14, this does not relieve the examiner from the burden of establishing a *prima facie* case of obviousness for claims 1-14. An admission that claims are not patentably distinct from one another is in no way an admission that those claims are not patentably distinct from the prior art. There is no basis for the examiner using an admission by Applicant to escape the burden of establishing a *prima facie* case of obviousness.

More particularly, claim 5 recites, "collecting associated price data for the item name over a given period of time to produce historical price data"; claim 6 recites, "wherein the profile includes matching criteria that must be met for the item name"; claim 7 recites, "wherein the matching criteria is an exact match"; claim 8 recites, "wherein the matching criteria is a fuzzy match"; claim 9 recites, "wherein the data

record also includes secondary source information"; claim 11 recites, "wherein the given product profile also includes a list of excluded items"; and, claim 12 recites, "wherein the given product profile also includes a next scan date." The Office Action fails to address these limitations, particularly as allegedly taught or suggested prior to invention by the applicant. Therefore, the Office Action fails to establish a *prima facie* case of obviousness for these claims.

Therefore, the rejection of claims 1-14 under 35 U.S.C. § 103 is improper and should be withdrawn.

The Office Action further states:

After careful review of the specification and prosecution history, the Examiner is unaware of any desire -- either expressly or implicitly -- by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) ("[t]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art."); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a "heavy presumption that a claim term carries its ordinary and customary meaning."). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In accordance with the ordinary and accustomed meaning presumption, during examination the claims are interpreted with their "broadest reasonable interpretation ..." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

However, if Applicants disagree with the Examiner and have either (a) already used lexicography or (b) wish to use lexicography and therefore (under either (a) or (b)) desire a claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully request Applicants in their next response to expressly indicate the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, ("[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must 'clearly set forth' or 'clearly redefine' a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term"). The Examiner cautions that no new matter is allowed.

✱ Failure by Applicants in their next response to properly traverse this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicants to forgo lexicography in this application and to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner's position that above requirements are reasonable. Unless expressly noted otherwise by the Examiner, the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

Office Action, dated July 29, 2003. Applicant respectfully disagrees. Examiner is correct in stating that the applicant has the right to be his or her own lexicographer. However, this right may be invoked at any time during the prosecution of the application. The examiner has no authority to impose a time limit on this right. Therefore, failure to traverse or respond to this issue in no way constitutes a desire by Applicant to waive Applicant's right to be his or her own lexicographer. The examiner has no authority to revoke this right.

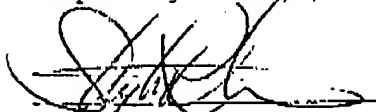
V. Conclusion

It is respectfully urged that the subject application is patentable over Streetprices and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: Oct 29, 2003

Respectfully submitted,



Stephen R. Tkacs
Reg. No. 46,430
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001
Agent for Applicants